



UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ELISABETH LAKSO,
EVA SIMMONS, HANNELE NURMI, ANNA KARIN JONBRINK
and
ANDERS SILFVERSTRAND

Application 09/720,908

ORDER RETURNING UNDOCKETED APPEAL TO EXAMINER

This application was received electronically at the Board of Patent Appeals and Interferences on March 27, 2006. A review of the application has revealed that the application is not ready for docketing as an appeal. Accordingly, the application is herewith being electronically returned to the examiner. The matters requiring attention prior to docketing are identified below:

A review of the file indicates that appellants filed an Appeal Brief on April 1, 2005 using the format set forth in 37 CFR § 41.37(c). However, the Appeal Brief does not fully comply with 37 CFR § 41.37(c).

37 CFR § 41.37 states:

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(c)(1) The brief shall contain the following items under appropriate headings and in the order indicated in paragraphs (c)(1)(i) through (c)(1)(x) of this section, except that a brief filed by an appellant who is not represented by a registered practitioner need only substantially comply with paragraphs (c)(1)(i) through (c)(1)(iv) and (c)(1)(vii) through (c)(1)(x) of this section:

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(ix) *Evidence appendix.* An appendix containing copies of any evidence submitted pursuant to §§ 1.130, 1.131, or 1.132 of this title or of any other evidence entered by the examiner and relied upon by appellant in the appeal, along with a statement setting forth where in the record that evidence was entered in the record by the examiner. Reference to unentered evidence is not permitted in the brief. See § 41.33 for treatment of evidence submitted after appeal. This appendix may also include copies of the evidence relied upon by the examiner as to grounds of rejection to be reviewed on appeal.

(x) *Related proceedings appendix.* An appendix containing copies of decisions rendered by a court or the Board in any proceeding identified pursuant to paragraph (c)(1)(ii) of this section.

(2) A brief shall not include any new or non-admitted amendment, or any new or non-admitted affidavit or other evidence. See § 1.116 of this title for amendments,

affidavits or other evidence filed after final action but before or on the same date of filing an appeal and § 41.33 for amendments, affidavits or other evidence filed after the date of filing the appeal.

(d) If a brief is filed which does not comply with all the requirements of paragraph (c) of this section, appellant will be notified of the reasons for non-compliance and given a time period within which to file an amended brief. If appellant does not file an amended brief within the set time period, or files an amended brief which does not overcome all the reasons for non-compliance stated in the notification, the appeal will stand dismissed.

(e) The time periods set forth in this section are extendable under the provisions of § 1.136 of this title for patent applications and § 1.550(c) of this title for ex parte reexamination proceedings.

An in-depth review of the Appeal Brief indicates that the following sections are missing:

- 1) "Evidence appendix," as set forth in 37 CFR § 41.37(c)(1)(ix); and
- 2) "Related proceedings appendix," as set forth in 37 CFR § 41.37(c)(1)(x).

A substitute brief that is in compliance with § 41.37(c) is required. For more information, see the United States Patent and Trademark website www.uspto.gov, and, in particular, the web page entitled "More Information on the Rules

of Practice Before the Board of Patent Appeals and Interferences, Final Rule" located at the following URL:

www.uspto.gov/web/offices/dcom/bpai/fr2004/moreinfo.html

In addition, the Examiner's Answer mailed June 3, 2005 does not comply with the headings as set forth in the new rules under 37 CFR § 41.37(c). See MPEP § 1207.02. Correction is required.

On page 7 of the Examiner's Answer, the examiner listed the following references under the heading "(9) Prior Art of Record":¹

4,232,179	Barrocas et al.	11-1980
5,417,679	Toms et al.	5-1995
94/07941	Cargill, Inc. (PCT)	4-1994
5,176,669	Klemp	1-1993
5,024,672	Widlund	6-1991
4,582,550	Sigl	4-1986

Brady, George S., "Polyethylenes", Materials Handbook, 13th ed., 1991, pp. 651-652.

It is noted that the Muller et al. '455, Owen et al '147 and Hsia et al. '812 references cited on page 7 of the Examiner's Answer under the heading "(11) Response to Argument" are not included as "Evidence Relied Upon." In accordance with § 1211 of the Manual

¹ This section has been renamed "Evidence Relied Upon" as set forth in the new rules under 37 CFR § 41.37(c). See MPEP § 1207.02.

of Patent Examining Procedure (MPEP) (8th Ed., Rev. 2, May 2004), clarification is required regarding the pertinence of the Muller et al., Owen et al. and Hsia et al. references. In addition, MPEP § 1207.02(A)(8) states:

(A) REQUIREMENTS FOR EXAMINER'S ANSWER.
The examiner's answer is required to include, under appropriate headings, in the order indicated, the following items:

. . . .

(8) Evidence Relied Upon. A listing of evidence relied on (e.g., patents, publications, admitted prior art), and, in the case of nonpatent references, the relevant page or pages.

If appropriate, compliance with MPEP § 1207.02(A)(8) is required in listing the Muller et al., Owen et al. and Hsia et al. references under the heading "Prior Art of Record [sic, "Evidence Relied Upon"]" appearing in the Examiner's Answer mailed June 3, 2005.

Accordingly, it is

ORDERED that the application is returned to the Examiner:

1) to hold the Appeal Brief filed April 1, 2005 defective;

2) for notification to appellants to file a substitute Appeal Brief in compliance with 37 CFR § 41.37;

3) for consideration of the substitute Appeal Brief;

4) for clarification under MPEP § 1211 regarding the pertinence of the Muller et al., Owen et al. and Hsia et al. references listed on page 7 of the Examiner's Answer mailed June 3, 2005;

5) if appropriate, for compliance with MPEP § 1207.02(A)(8) by listing the Muller et al., Owen et al. and Hsia et al. references in a new Examiner's Answer under the heading "Evidence Relied Upon";

6) for written notification to appellants regarding the action taken; and

7) for such further action as may be appropriate.

BOARD OF PATENT APPEALS
AND INTERFERENCES

By:



DALE M. SHAW
Program and Resource Administrator
(571) 272-9797

DMS/psb

Application 09/720,908

Buchanan Ingersoll PC
(Including Burns, Doane, Swecker & Mathis)
Post Office Box 1404
Alexandria, VA 22313-1404